



Y
AP

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: OTERO et al.

Application No.: 09/872,687

Filing Date: May 31, 2001

For: COMPUTERIZED INTERFACE FOR
CONSTRUCTING AND
EXECUTING COMPUTERIZED
TRANSACTION PROCESSES AND
PROGRAMS

) Confirmation No.: 3804

) Group Art Unit: 3691

) Examiner: Thu Thao Havan

) **RESPONSE TRANSMITTAL**

) Docket No.: G08.053

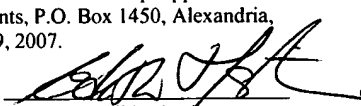
) **PTO Customer Number 28062**
) Buckley, Maschoff & Talwalkar LLC
) 50 Locust Avenue
) New Canaan, CT 06840

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 9, 2007.

Dated: February 9, 2007

By:


Edith Martin

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing are:

1. ☒ Supplemental Appeal Brief Response to Non-Final Office Action mailed November 15, 2006.
2. ☒ While no fees are believed due in conjunction with this response, the Commissioner is hereby authorized to charge and credit Deposit Account No. **50-1852** as described below. A duplicate copy of this sheet is enclosed.
 - i. ☒ Credit any overpayment.
 - ii. ☒ Charge any additional fees required under 37 CFR 1.16 and 1.17

3. . ☒ Additional Enclosures: Acknowledgement Postcard

Respectfully submitted,



February 9, 2007
Date

Nathaniel Levin
Registration No. 34,860
Buckley, Maschoff & Talwalkar LLC
50 Locust Avenue
New Canaan, CT 06840
(203) 972-3460



Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: OTERO et al.

Application Serial No.: 09/872,687

Filing Date: May 31, 2001

For: COMPUTERIZED INTERFACE FOR
CONSTRUCTING AND
EXECUTING COMPUTERIZED
TRANSACTION PROCESSES AND
PROGRAMS

) Confirmation No.: 3804

) Group Art Unit: 3691

) Examiner: Thu Thao Havan

) **SUPPLEMENTAL APPEAL BRIEF**

) Attorney Docket No.: G08.053

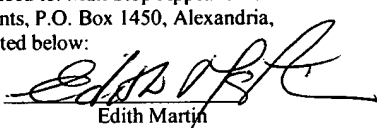
) **PTO Customer Number 28062**
) Buckley, Maschoff & Talwalkar LLC
) Five Elm Street
) New Canaan, CT 06840

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date noted below:

Dated: February 9, 2007

By:


Edith Martin

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is filed in response to the non-final Office Action issued on November 15, 2006, which in turn was in response to the Appeal Brief filed by appellants on August 17, 2006. Appellants hereby request reinstatement of the appeal, and accordingly submit this Supplemental Appeal Brief to respond to the Examiner's new ground of rejection.

I. New Ground of Rejection

The Examiner has modified the rejection previously appealed from by purporting to combine the Maves reference (U.S. Patent No. 6,125,442) with the previously asserted combination of Magill and Kane. In essence, the Examiner seems to have taken appellants' point¹ that Magill's disclosure of changing a color in a display fails to satisfy the claim feature of a user employing an interface to modify a trading algorithm by changing a mapping between an event and an action. However, this was not the only significant flaw in the rejection as previously asserted, and the new rejection adds further errors to those that previously existed. In regard to the flaws in the original rejection² that are carried over in the new rejection, this Honorable Board is respectfully referred to pages 8 and 9--Sections II.B., III and IV--of the Appeal Brief of August 17, 2006.

II. Relevance of Maves reference

Rather than focusing on a particular disclosure in the Maves reference, the Examiner has unhelpfully "string-cited" the entire "Summary of the Invention" section of Maves, running from column 2 to column 7. The Examiner also referred to FIGS. 13-15 of the reference. As best as appellants can determine, the central point of Maves, upon which the Examiner appears to rely, is a structure for software programming in which a Run Time Events Manager (RTEM) is provided to select for execution a particular Model from a number of Models that are registered with the RTEM. With such a structure, the program can be substantially modified, by introducing new Models, without requiring rewriting, debugging, etc. of the RTEM and the other Models.

The flow charts which appear in FIGS. 13-15 have nothing to do with events or actions or changing mappings therebetween, and do not appear to have any particular relevance to the issues in this appeal.

¹ Made at pages 6-7 of the Appeal Brief of August 17, 2006, and previously at page 6 of the Amendment filed on October 21, 2005.

² Stated in Office Action dated September 23, 2005; maintained in Final Office Action dated January 11, 2006.

III. The Examiner's proposal to combine Maves with Magill and Kane is not supported by any suggestion in the prior art.

Essentially the Examiner proposes to combine (a) Magill's interactive trading order book³, (b) Kane's "intelligent agents"⁴, and (c) Maves's Run Time Events Manager. However, the Examiner's proposal to combine Maves with the other two references suffers from the same technical and formal defect as his proposal to combine Kane with Magill.⁵ This is not a mere technicality but rather goes to the heart of whether the Examiner's proposed combination of references is properly made. The defect is that the Examiner merely states as a conclusion that

it would have been obvious ... to modify [the? an?] algorithm by changing a mapping between an event and an action to perform and execute a software application when customizing a new application for a particular software module as disclosed in Maves.⁶

The Examiner fails to state any benefit, motivation, purpose, reason or suggestion to support his proposal to combine the teachings of Maves with those of Magill and Kane. Thus, as in his proposal to combine Kane with Magill, the Examiner has failed--with respect to the further combination with Maves--to satisfy the requirement of *In re Kotzab*⁷ that some motivation, suggestion or teaching in the prior art support the proposed combination.

The Examiner's rejection of claim 1 is not carefully and logically constructed. Rather, the rejection is thrown together with mismatched parts, using the language of claim 1 as a guide. This approach on the part of the Examiner violates the dictates of the Court of Appeals for the Federal Circuit, as set forth in cases such as *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321,1329 (Fed.Cir. 1998) ("Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the ... invention."); *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902,

³ See page 6, first paragraph, of the Appeal Brief dated August 17, 2006.

⁴ See page 6, second paragraph of the Appeal Brief dated August 17, 2006.

⁵ See page 8 of the Appeal Brief dated August 17, 2006.

⁶ Page 4, lines 13-16 of the Office Action dated November 15, 2006.

⁷ 217 F.3d 1365 (Fed.Cir. 2000).

907, 5 USPQ2d 1788, 1792 (Fed.Cir. 1988) (“Care must be taken to avoid hindsight reconstruction by using ‘[the claims] as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims’”); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”); *In re Fritch* 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed.Cir. 1992) (“[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’”).

In sum, the Examiner has set forth no logic or suggestion to support the proposed combination of references. Instead, he merely invokes the stock phrase, “it would have been obvious,” and waves a magic wand, in the hope that the disparate pieces lifted from the references will adhere to each other as a simulacrum of the claimed invention. There could hardly be a clearer case of using the claim at issue as a template to cull selected features from the prior art. The Examiner’s rejection is just a hindsight reconstruction, and falls far short of what is required for a *prima facie* case of obviousness.

IV. Even with the addition of the Maves reference, the proposed combination fails to satisfy elements of the claims.

The citation of the Maves reference appears to be an artifact of keyword searching--the words “event” and “action” appear in the text of the reference, but the reference has nothing to do with the claimed concept of a user employing an interface to change a mapping between an event and an action, much less doing so to modify a trading algorithm. Even if Maves arguably discloses changing a mapping between an event and an action, such is not done in Maves either with an interface or by a user. Rather, at most, mappings are changed by a Run Time Events Manager (RTEM), which is a software entity⁸, not a user. If any individual could be said to

⁸ At column 2, line 32 of Maves it is stated that the RTEM is an “application-independent software entity”. To similar effect at lines 8-9 of the Abstract, the RTEM is “a fetch-execute loop implemented in code”.

change a mapping between an event and an action in Maves's software system, it would be the programmer who introduces a new "Model" for possible selection by the RTEM, not a user of an application interface.

It is also notable that Maves has nothing to do with trading software systems, and, like the other two references, is irrelevant to allowing a user to modify a trading algorithm.

Accordingly, Maves fails to fill the gap in the rejection left when the Examiner gave up on his contention that a change in display color was a change in mapping an event to an action. Even if Maves were properly to be combined with the other references, the resulting combination still fails to teach or suggest a salient feature of the claims, namely using an interface to modify a trading algorithm by changing a mapping between an event and an action.

CONCLUSION

The Examiner's "new, improved" rejection is as rickety and flawed as the rejection originally appealed from. This Honorable Board is respectfully requested to reverse the pending rejection.

Since this Supplemental Brief is filed within three months from the date of mailing of the Office Action dated November 15, 2006, no extension of time or other fee is believed due. However, if any fees are due in conjunction with this matter, the Commissioner is hereby authorized to charge them to Deposit Account 50-1852.

If any issues remain, or if the Examiner or the Board has any further suggestions for expediting allowance of the present application, kindly contact the undersigned using the information provided below.

Respectfully submitted,



Nathaniel Levin
Registration No. 34,860
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-3460

February 9, 2007
Date